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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,057	11/03/2006	Jan Ludwig Goeman	TIP0044-USPCT	1285

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EXAMINER	
MCINTOSH III, TRAVISS C	
ART UNIT	**PAPER NUMBER**
1623	

MAIL DATE	DELIVERY MODE
05/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/540,057	GOEMAN ET AL.	
	Examiner	Art Unit	
	TRAVISS C. MCINTOSH III	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *6-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/30/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Examiner of the U.S. Patent application SN 10/540,057 has changed. In order to expedite the correlation of papers with the application please direct all future correspondence to the Technology Center 1600, Art Unit 1623, attn: Examiner Traviss McIntosh.

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 2/9/2009 is acknowledged.

Claims 1 and 2 have been amended.

Claims 6-12 have been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines Ri and R2 as various substituents. However, it is noted that the examiner is not able to locate any Ri variables. It is noted that the examiner has interpreted Ri as R_1 from the structure. Also, R2 has been interpreted as R_2 as depicted in the structure. Appropriate correction is required.

Claim 1 defines Ri and R2 (interpreted as R_1 and R_2 as set forth supra) as various moieties including "$R_4$0-". The zero is believed to be an "O" and is actually "R_4O-". Appropriate correction is required.

Claim 1 and 2 provide for various Markush groups which are not properly set forth in the alternative. The word "or" should be included between the last 2 groups for the definitions of "R_1 and R_2", "R_3", and "R_4, R_5, R_6, R_7, and R_8".

Claims 1 and 2 are indefinite for the terms "mono- or polysaccharide derivative", "phosphate derivative", or "sulfate derivative". In the absence of the identity of moieties intended to modify an art recognized chemical core, described structurally or by chemical name, the identity of a derivative would be difficult to ascertain. In the absence of said moieties, the claims containing the term "derivative" are not described particularly sufficiently to distinctly point out that which applicant intends as the invention.

It is unclear what is intended by the terms "Het^1" and "Het^2". These terms are included in claims 1 and 2, but are not defined. It is noted that if applicants are relying on the specification for a definition, the specification must clearly set forth the definition explicitly and with reasonably clarity, deliberateness, and precision. See ***Teleflex Inc. v. Ficosa North America Corp., 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); Rexnord Corp. v. Laitram Corp., 60 USPQ2d 1851, 1854 (Fed. Cir. 2001);*** and MPEP 2111.01. Likewise, while the claims will be read in light of the specification, limitations from the specification are not read into the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

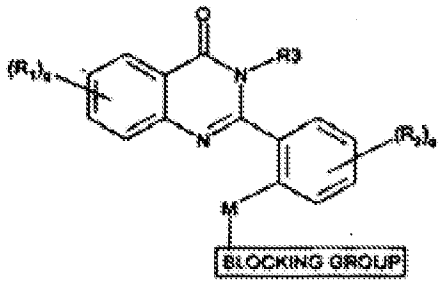
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molecular Probes, Inc (WO93/04077).

The claims of the instant application are dawn to various compounds having the structure: 

wherein the variables are defined in the claim. Applicant's novelty appears to lie in the proviso that at least one of variables R_1, R_2, or R_3 is a moiety with at least 4 carbon atoms.

The '077 document is drawn to various enzyme substrates overlapping in structure with those instantly claimed. See claim 7 for example, where W is N-R and R is an alkyl group containing 4 carbon atoms. Obviousness based on similarity of structure and function entails motivation to make claimed compound in the expectation that compounds similar in structure will have similar properties. Where the prior art compounds essentially bracket the claimed compounds and are known to be effective as well known pesticides, for example, one of ordinary skill in the art would be motivated to make the claimed compounds in searching for new pesticides. See ***In re Payne, 606 F.2d 303, 203 USPQ 245, 254-55 (CCPA 1979).*** Exemplary rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) " Obvious to try " – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The instant case would meet the requirements for Obvious to Try. It is noted in claim 7 of the '077 document there are only 6 different moieties for W and also few choices for lower alkyl groups which have between 1 and 4 carbon atoms. As such, there is seen to be a finite number of identified, predictable solutions wherein the skilled artisan would have a reasonable expectation of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traviss C McIntosh III/
Primary Examiner, Art Unit 1623
May 19, 2009